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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/748,953	12/30/2003	Mary Rose Rice	076360.011600(275-3119-U)	7896
33717 7590 08/25/2009 GREENBERG TRAURIG LLP (L.A.) 2450 COLORADO AVENUE, SUITE 400E INTELLECTUAL PROPERTY DEPARTMENT SANTA MONICA, CA 90404				
EXAMINER CASCHERA, ANTONIO A				
ART UNIT 2628		PAPER NUMBER		
NOTIFICATION DATE 08/25/2009		DELIVERY MODE ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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### Office Action Summary

**Application No.**

10/748,953

**Applicant(s)**

RICE, MARY ROSE

**Examiner**

Antonio A. Caschera

**Art Unit**

2628

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 10 August 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-6, 8, 10, 12, 45-50 and 54-77 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-6, 8, 10, 12, 45-50, 54-59 and 67-77 is/are allowed.
- 6) ☒ Claim(s) 60-65 is/are rejected.
- 7) ☒ Claim(s) 66 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 November 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-849)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. Claims 60-63 and 65 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wise (U.S. Patent 2,866,277) in view of Simonis (U.S. Publication 2004/0004639).

In reference to claim 60, Wise discloses a paint color display system to assist customers in selection of paint colors (see column 1, lines 15-20 wherein Wise discloses a method and means for selecting, matching and compounding paint colors in a coating process.) comprising:

*a plurality of physical color combination cards including a plurality of paint samples wherein the plurality of paint samples for each physical color combination card includes at least a base hue sample and a plurality of complementary color samples arranged adjacent to the base hue sample (see column 7, lines 43-71 and Figure 2 wherein Wise discloses a color chart comprising a plurality of color chips that includes a base hue chip and a plurality of complementary color chips arranged adjacent to the hue via arcs surrounding the hue based chip. Further, Wise discloses arranging shades of the complemented color around the base hue chip again, on the arcs surrounding the hue (see column 8, lines 3-35), and wherein each physical color combination card includes a picture of a room or building that is painted with the plurality of paint samples.*

Wise however, does not explicitly disclose a plurality of such color charts comprising the hue and complement colors. It would have been obvious to one of ordinary skill in the art at the time the invention was made to duplicate or replicate the color chart and associated elements of Wise, that represents a single hue chip, to display a plurality of different hue color chip charts since it has been held that a duplication or parts for a multiplied effect is not a type of innovation which a patent is to be granted (see *St. Regis Paper Co. vs. Bemis Co., Inc.*, 193 USPQ 8, 11 (7<sup>th</sup> Cir. 1977)). Wise does not explicitly disclose each of the color charts including a picture of a room or building that is painted with the color chips. Simonis discloses a decorating design color selection system that gives a user a view of a finished product before a job is actually done (see paragraphs 4-5). Simonis discloses the invention including a color palette with color numbers of paints for allowing the user to select colors from sample paint strips and the outlines of the portions of the “job” (i.e. house) to be painted using such colors (see paragraphs 8-19 and the Figure on page 2 of the Publication). It would have been obvious to one of ordinary skill in the art at the time the invention was made to implement the color painted associated picture/room techniques of Simonis with the color chart production techniques of Wise in order to give a “preview” of a certain range of colors as applied to a physical environment/scene (see paragraph 5, lines 1-4 of Simonis) thereby giving a user a better idea of the what the outcome of such colors would physically look like.

In reference to claim 61, Wise and Simonis disclose all of the claim limitations as applied to claim 60 above in addition, Wise discloses the central hue chip (#21 of Figure 2) larger in size than complement chip #26.

In reference to claim 62, Wise and Simonis disclose all of the claim limitations as applied to claim 60 above in addition, Wise discloses one of the complementary color chips located on the outside arc from the hue chip as white (see #21a, 21 of Figure 2).

In reference to claim 63, Wise and Simonis disclose all of the claim limitations as applied to claim 60 above. The Examiner interprets that it would have been obvious to one of ordinary skill in the art at the time the invention was made to duplicate or replicate the color chart and associated elements of Wise and color painting picture/room techniques of Simonis to display a plurality of different hue color chip charts comprising painted scenes, disclosed by Simonis, since it has been held that a duplication or parts for a multiplied effect is not a type of innovation which a patent is to be granted (see St. Regis Paper Co. vs. Bemis Co., Inc., 193 USPQ 8, 11 (7<sup>th</sup> Cir. 1977)).

In reference to claim 65, Wise and Simonis disclose all of the claim limitations as applied to claim 63 above in addition, Simonis discloses allowing for four different houses/scenes/environments including the addition of a user's own photo to be incorporated in the painted colors (see paragraph 5). It would have been obvious to one of ordinary skill in the art at the time the invention was made to implement the multiple and different houses/scenes/environment displaying techniques of Simonis on the previously held as obvious, multiple color charts in order to provide varying scenes to the user thereby giving a greater sense of realism to the paint colors.

2. Claim 64 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wise (U.S. Patent 2,866,277), Simonis (U.S. Publication 2004/0004639) and further in view of Remmers (U.S. Patent 2,300,360).

In reference to claim 64, Wise and Simonis disclose all of the claim limitations as applied to claim 63 above. Neither Wise nor Simonis disclose the color chart configured with at least three sections in a tri-fold card. Remmers discloses a color selecting chart which is configured in a folding card that has at least three sections (see column 1, lines 1-8, 26-32 and Figures 1-2). It would have been obvious to one of ordinary skill in the art at the time the invention was made to implement color card folding packaging techniques of Remmers with the color chart and scene displaying techniques of Wise and Simonis in order to provide color selection techniques to a user in a small easy to care package which may fold and fit in a pocket (see column 1, lines 9-12 of Remmers).

#### ***Response to Arguments***

3. Applicant's arguments, see pages 10-12 of Applicant's Remarks, filed 08/10/09, with respect to the objection of claim 67 have been fully considered and are persuasive. The objection of claim 67 has been withdrawn.
4. Upon an updated prior art search, the Wise reference has been found to be directly applicable to Applicant's invention in view of at least claim 60 therefore the above rejection is necessitated.

#### ***Allowable Subject Matter***

5. Claims 1-6, 8, 10, 12, 45-50, 54-59 and 67-77 are allowed.

The following is a statement of reasons for the indication of allowable subject matter:

In reference to claims 1, 8 and 67, the prior art of record does not explicitly disclose arranging a first plurality of physical paint sample cards on a display unit so that they are arranged in groups of varying hue in a first direction and chroma in a second direction while further arranging one or more combination or coordination paint sample cards adjacent each group of different hue and chroma physical paint sample cards, each color combination or coordination paint sample card containing a plurality of paint samples having the same base hue as the hue of a group it is adjacent to with a picture of a building or room painted with the plurality of colors on the color combination paint sample card, in combination with the further limitations of claims 1, 8 and 67 respectively.

In reference to claims 2-6, 10, 12, 54-59 and 68-77, claims 2-6, 10, 12, 54-59 and 68-77 depend upon allowable claims 1, 8 and 67 and are therefore also deemed allowable.

In reference to claim 45, the prior art of record does not explicitly disclose a first plurality of paint sample cards arranged in hue groups, arranging one or more color combination style cards adjacent to each group of different hue, each combination card having a tri-fold card with three separate sections, each section containing a plurality of paint samples and a picture of a room painted with the plurality of paint samples on the section, each section of the tri-fold card having a picture of a different room, in combination with the further limitations of claim 45.

In reference to claims 46-50, claims 46-50 depend upon allowable claim 45 and are therefore also deemed allowable.

6. Claim 66 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Antonio Caschera whose telephone number is (571) 272-7781. The examiner can normally be reached Monday-Friday between 7:00 AM and 3:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kee Tung, can be reached at (571) 272-7794.

**Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks  
Washington, D.C. 20231

**or faxed to:**

**571-273-8300 (Central Fax)**

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Technology Center 2600 Customer Service Office whose telephone number is (571) 272-2600.

/Antonio A Caschera/

Primary Examiner, Art Unit 2628

**8/21/09**